

### **THE OFFICE ACTION**

In the Office Action issued on December 23, 2003, the Examiner withdrew the indicated allowability of claims 1-5, and 7-11 and rejected claims 1, and 3-5 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,250,771 to Sharrah et al. ("Sharrah") in view of U.S. Patent 6,024,471 to McDermott ("McDermott"). The Examiner also rejected claim 2 and 7-11 under 35 U.S.C. §103(a) as being unpatentable over Sharrah in view of McDermott and further in view of U.S. Patent 6,095,661 to Lebens et al. ("Lebens"). The Examiner also rejected claims 12, 14-17, and 20-23 under 35 U.S.C. §103(a) as being unpatentable over Lebens in view of McDermott.

### **REMARKS**

#### **I. Claims 1 and 3-5 are Patentable Over Sharrah in View of McDermott**

The Examiner rejected claims 1 and 3-5 under 35 U.S.C. §103(a) as being unpatentable over Sharrah in view of McDermott. Applicants respectfully traverse.

It was the Examiner's opinion that "Sharrah discloses a housing (20), a [sic] least one LED within housing (286), a reflector extending from an end of the housing for focusing and dispersing the LED beam to a desired light contour (200, 390 [sic, 290], col. 3 lines 5-26, focusing ring aids in moving reflector 300 to focus emitted light), the housing encloses a series of batteries, the reflector is selectively adjustable (col. 3, lines 5-26). Sharrah discloses the claimed invention except for the recitation of an adjustable switch coupled to the variable resistor. McDermott discloses an adjustable switch coupled to the variable resistor for controlling the level optical output of flashlight (50), being a rheostat having continuous variable control."

First, there is no motivation to combine the teachings of the two references. To properly reject a claim under §103, there must be some suggestion or motivation to combine the two references. Absent such a suggestion, there would be no reason why one skilled in the art would consult the particular combination of references cited by the Examiner.

To maintain an obviousness rejection based on a combination of references, the Examiner must present facts and reasons supporting his conclusion that it would be obvious to combine those references. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). By failing to provide a full and reasoned explanation for his obvious to combine conclusion, the Examiner has failed to meet his burden under §103.

Here, Sharrah is directed to a flashlight having two distinct lighting elements 285, 286 that may be operated separately. The flashlight has a main body 20 for holding the battery pack 100 and a lamp head 200 containing the lighting elements and reflector 300. McDermott, on the other hand, is concerned with a switch for a flashlight capable of providing a variety of output light modes by varying the intensity of the emitted light by varying the voltage supplied to the light.

The invention of Sharrah, unlike McDermott, is only capable of providing two states for each element, "ON" and "OFF". The Examiner's contention that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the adjustable switch of McDermott in the flashlight of Sharrah for the purpose of providing the flashlight with a selective optical output since McDermott teaches that the variable switch is desirable for controlling and selecting a desired light intensity" is flawed for several reasons. In this respect, the variable resistor type control of McDermott would not be suitable for use in a device such as Sharrah that utilizes two separate types of lighting elements. In fact, a variable resistor type control for the device of Sharrah would be impractical and unworkable based on the fact that the light intensity of an LED and an incandescent bulb do not vary uniformly with changes in voltage. That is, one could not accurately control the light output of both the LED and incandescent bulb using a variable resistor type control. The brightness of the two elements would vary independently. Thus, the references actually teach away from such a combination. The two references are concerned with completely different objects and provide no incentive for one skilled in the art to combine their teachings.

Second, even if the references could somehow be combined, they would still not teach all of the elements of the present claims. In this respect, such a combination fails to teach or suggest a flashlight with at least one LED mounted *within* a housing and a reflector *extending from an end* of the housing. As can be clearly seen, and despite the Examiner's arguments, Sharrah discloses a two part light including a body (20) and a lamp head (200). Both of the lamp elements (285,286) are mounted within the lamp head. The reflector (300) of Sharrah is also mounted within the lamp head rather than extending from an end of it. Likewise, McDermott fails to disclose any reflector. Since neither reference alone discloses nor suggests this feature, any combination of the two references would lack such a reflector element as well.

With respect to claim 5, the Examiner's contention that the point of

reference with regard to movement is arbitrary is not convincing. Obviously, the (unstated) point of reference is with respect to the body of the flashlight. Any other interpretation of the claim is impossible since one would have no idea as to the how to determine what element is in fact moving. If the Examiner was confused, then a §112 rejection should have been made. The fact that one was not made shows that the Examiner clearly understood the scope and intent of the claim. To now make such a strained interpretation of the claim language for the sake of a prior art rejection defeats the clear intent of the claim. In light of this, neither Sharrah nor McDermott discloses or suggests a flashlight wherein the reflector is fixed with respect to the flashlight body and the LED is movable. Thus, any proposed combination of the two fails to disclose such a feature as well.

## **II. Claims 2, and 7-11 are Patenable Over Sharrah in View of McDermott and Further in View of Lebens**

The Examiner rejected claim 2 and 7-11 under 35 U.S.C. §103(a) as being unpatentable over Sharrah in view of McDermott and further in view of Lebens. Applicants respectfully traverse.

In support of the rejection, the Examiner stated "Sharrah and McDermott teach the invention as stated above but do not teach a plurality of LEDs arranged concentrically around a single LED. Lebens teaches a flashlight with a plurality of LEDs arranged concentrically around a single LED. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a multiple amount of LEDs in a flashlight device as taught by Sharrah and McDermott since as taught by Lebens, such a configuration for use in a flashlight is useful so as to provide the user with a desired color output from the multitude of LEDs. Lebens discloses a switch to turn on and off a select number of at least one LED."

First, there is no motivation to combine the three references. The Examiner states that Lebens discloses a plurality of LEDs arranged concentrically around a single LED. Even assuming this to be true, Lebens cannot be combined with Sharrah because the focusing major and minor parabolic reflecting surfaces 300, 306, would not function properly with a plurality of LEDs as a light source. In this respect, the Examiner is directed to column 7, lines 8-27 of Sharrah which states

"The reflector includes two parabolic reflecting surfaces. The first is a major parabolic reflective surface generally symmetric about an axis through the central aperture 308. Nested within

a sector of the major parabolic surface is a second minor parabolic reflecting surface 306 that is generally symmetric about an axis through the aperture 309...The major parabolic reflective surface 304 provides a reflective surface for the central lamp element 286 and the minor parabolic reflective surface 306 provides a reflective surface for the second lamp element 285. ***Because of this unique configuration, the minor reflective surface 306 does not substantially interfere with the reflection of the light from lamp element 286 off of the major reflective surface 304.***” (emphasis added)

Thus, for the invention of Sharrah to work correctly, a single lamp element must be positioned in the center of each parabolic reflective surface. A plurality of LEDs arranged concentrically in a circle would disrupt the efficiency of Sharrah, and cause the minor reflective surface 306 to substantially interfere with the reflection of the light from lamp element 286 off of the major reflective surface 304. Thus, Sharrah actually teaches away from a concentric arrangement of multiple LEDs. There is absolutely no motivation to combine Sharrah, McDermott and Lebens.

Second, even assuming the propriety of combining the references, such a combination would still not disclose or suggest all of the elements of the present claims. In this respect, rejected claims 2 and 7-11 depend from claim 1, and therefore contain all of the elements thereof. Thus, even assuming Lebens discloses the specific features recited in these claims, the stated combination of Sharrah, McDermott and Lebens fails to disclose or suggest all of the elements found in claim 1 (and implicitly claims 2 and 7-11) for the reasons stated above. Applicants therefore respectfully request withdrawal of this rejection.

### **III. Claim 12, 14-17 and 20-23 are Patentable over Lebens in View of McDermott**

The Examiner rejected claims 12, 14-17, and 20-23 under 35 U.S.C. §103(a) as being unpatentable over Lebens in view of McDermott. Applicants respectfully traverse.

In support of the rejection, the Examiner states that “Lebens does not disclose a reflector extending from the housing. McDermott discloses a reflector extending from the housing for focusing and dispersing light.” Despite the Examiner’s arguments, McDermott does NOT disclose a reflector extending from the housing. McDermott does disclose a lens 37, but this lens is transparent to light emitted by the lighting element, and is thus not a “reflector”. Therefore, because neither Lebens nor

McDermott disclose or suggest a reflector, any proposed combination of the two references also fails to disclose or suggest such an element.


### **CONCLUSION**

In view of the above amendments and remarks, Applicants respectfully submit that the rejections set forth in the Office Action of December 23, 2003 have been overcome. Accordingly, Applicants submit that all pending claims, claims 1-5, 7-17 and 19-23 are in condition for allowance. Withdrawal of the rejections and early notification of allowability are earnestly solicited. Should any issued remain, the Examiner is encouraged to contact the undersigned to resolve any such issue.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & MCKEE, LLP

Date: Jan 27, 2004

  
\_\_\_\_\_  
Scott A. McCollister, Reg. No. 33,961  
Joseph E. Waters, Reg. No. 50,427  
1100 Superior Avenue, Seventh Floor  
Cleveland, Ohio 44114-2518  
(216) 861.5582